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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant No.	Applicant(s)	
	09/333,821	LEVINE ET AL.	
	Examiner	Art Unit	
	CESAR B PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed on 6/28/2004.

This action is made Final.

2. In the amendment, claim 9 has been canceled. Claims 1-8, and 10-33 are pending in the case. Claims 1, 18, and 24 are independent claims.

3. The rejections of claims 1-2, 5, 6, 9-10, 12-13, 15-17, 24-25, and 27-31 under 35 U.S.C. 102(b) as being anticipated by Corel Wordperfect 6.1, 1996, hereinafter Wordperfect, "Scan Images into Wordperfect", and "Scanner Setup", "Image Settings", and "Image Tools" printouts, have been withdrawn as necessitated by the amendment.

4. The rejections of claims 2, 6, 10, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, and further in view of "Ulead PhotoImpact 3.0" User Guide for Windows 95 and Windows NT 3.51, hereinafter Photoimpact, Ulead Systems, 1996, pp.104-107, 111-114, 162-167, have been withdrawn as necessitated by the amendment.

5. The rejections of claims 4-5, 18, 21-23, and 32-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Sobol et al, hereinafter Sobol (Pat. # 5,907,665, 5/25/99), have been withdrawn as necessitated by the amendment.

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6. The rejections of claims 7-8, 19, and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Mastering Photoshop 5 for the Web, hereinafter Photoshop (1998, pp.1-10) , have been withdrawn as necessitated by the amendment.

7. The rejection of claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of "Troubleshooting and configuring the Windows NT/95 Registry", Clayton Johnson, hereinafter Johnson (1997, pp.1-2), has been withdrawn as necessitated by the amendment.

8. The rejection of claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of TWAIN specification version 1.8, 110/22/98, hereinafter Twain (IDS filed on 8/23/99), has been withdrawn as necessitated by the amendment.

9. The rejection of claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Arakawa (Pat. #5,845,076, 12/1/98), has been withdrawn as necessitated by the amendment.

10. The rejection of claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Sobol, and further in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96) , has been withdrawn as necessitated by the amendment.

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11. The rejection of claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, further in view of Hearn et al, hereinafter Hearn (Pat. # 6,154,756, 11/28/00, filed on 7/1/96), has been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 112

12. The rejections of claims 18-23 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3, 15-16, 24-25, 27-28, and 29-31 rejected under 35 U.S.C. 103(a) as being anticipated by Corel Wordperfect 6.1, 1996, hereinafter Wordperfect, "Scan Images into Wordperfect", and "Scanner Setup", "Image Settings", and "Image Tools" printouts, in view of "Twain White Paper", hereinafter Twain, <http://www.twain.org>, 1996, pp. 1-4, as cited in paper 18.

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Regarding independent claim 1, Wordperfect teaches the acquisition, and insertion of a scanned image(s), from a TWAIN scanner, under control of a wordprocessing application, into a textual document(s) located in a Wordprocessing application (pages 1, 5). In other words, the scanner is activated once user selects the "Acquire" command from the "Insert" menu. The insertion of the scanned image(s) into the textual document(s) is done directly from the scanner, that is without saving the image into a permanent file in the computer memory prior to inserting the file into the textual document. Wordperfect fails to explicitly disclose: *(c) causing the application program to negotiate with the image source device that is active to determine a set of image capture parameters that control said image source device when acquiring the image.* However, Twain discloses that a user's selection triggers the providing of negotiated settings by a negotiation process between an application-- *causing the application program to negotiate--*, describing the data it wants, and a source device, defining the data it can provide (page 4, lines 12-17). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Twain, because Wordperfect discloses the acquisition of images from a scanner directly from the user. Thus, freeing up the user from having to determine what are the capabilities of the scanner.

Claim 3 is directed towards a method for implementing the steps found in claim 1, and therefore is similarly rejected.

Regarding claim 15, which depends on claim 12, Wordperfect discloses the automatic scan of images into a document using only TWAIN enabled scanners, thereby determining

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whether the device(s) is TWAIN compliant, and only using a single user selection of an “acquire” option from an insert menu (pages 1-2).

Claim 16 is directed towards a computer-readable medium for storing the steps found in claim 1, and therefore is similarly rejected.

Claims 24-25 are directed towards a system for implementing the steps found in claims 1, and 1 respectively, and therefore are similarly rejected.

Regarding claim 27, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) produced with a wordprocessor—*presentation design application* (pages 1-2, 5).

Regarding claim 28, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) (pages 1-2, 5).

Claim 29 is directed towards a system for implementing the steps found in claim 15, and therefore is similarly rejected.

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Regarding claim 30, which depends on claim 24, Wordperfect discloses the automatic scan of images into a document using only a using a single user selection of an “acquire” option from an insert menu (page 1).

Regarding claim 31, which depends on claim 24, Wordperfect discloses allowing a user to customize or enhance the image settings to be inserted into the document. This enhancement is done from within the wordprocessor (page 7).

15. Claims 2, 6, 10, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, and further in view of “Ulead PhotoImpact 3.0” User Guide for Windows 95 and Windows NT 3.51, hereinafter Photoimpact, Ulead Systems, 1996, pp.104-107, 111-114, 162-167.

Regarding claim 2, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document (page 2). Wordperfect fails to explicitly disclose: *a list of all image source devices in communication with the computer*. However, Photoimpact discloses the selection of a specific device from a list including all the devices connected to a pc for scanning images into the pc (page162, lines 28-38). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the selection of one device out of all the devices connected to the pc,

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because the computer does not know which device the user wants to use to acquire the image, the user must choose, when there are more than one device connected to the computer.

Regarding claim 6, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating--* an image into a document (page 2). Wordperfect fails to explicitly disclose: *(a) selecting at least one image enhancement criterion, and(b) enhancing said captured image based on said image enhancement criterion, prior to inserting said data representing the image into said document.* However, Photoimpact discloses the setting of image calibration, and postprocessing options for adjusting, and enhancing images to be scanned into the computer-- *prior to inserting said data representing the image into said document* (page164, line 14-page 167). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance (page 165, lines 4-26).

Regarding claim 10, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating--* an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *the set of image capture parameters are negotiated based in part on the capabilities of said image source device.* However, Photoimpact discloses the setting of calibration, and postprocessing options for adjusting, and enhancing images to be scanned into the computer (page164, line 14-page 167). In other words, once the postprocessing

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options are selected, the photoimpact application negotiates with the scanning device the straightening, cropping, removing moiré, etc., -- *capture parameters are negotiated based in part on the capabilities of said image source device*-- of the image. This calibration is also based in part on the user's input. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance (page 165, lines 4-26).

Regarding claim 12, which depends on claim 1, Wordperfect discloses the scanning of images directly into a document (page 1). Wordperfect fails to explicitly disclose: *determining from within the application program whether the image source device that is active is able to perform an automatic image scan*. However, Photoimpact discloses the display of an error message, if a selected device is not a TWAIN device, and if there is a TWAIN device, but it is not properly configured, then a dialog box containing configuration options appears (page 163, line 8-17). In other words, when a user selects the acquire image button, instead of being able to automatically scan the image, the user is informed the automatic scan cannot be performed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses above the benefit of informing the user whether or not the device is properly configured.

Claim 17 is directed towards a computer-readable medium for storing the steps found in claim 12, and therefore is similarly rejected.

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16. Claims 4-5, 18, 21-23, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Sobol et al, hereinafter Sobol (Pat. # 5,907,665, 5/25/99).

Regarding claim 4, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating--* an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *scanning a graphic source that has defined edges, further comprising the steps of automatically detecting the edges of the graphic source, and cropping the image at the edges of the graphic source to exclude any portion of a scanned field.* However, Sobol discloses the selection of a specific portion of an image detecting the edges, thereby leaving unwanted data out, and cropping it to comply with the user's selection (col.4, lines 21-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches allowing the benefit of customizing a desired image by allowing the user to crop and select desired portions of the image. Therefore, a user would be able to select only the portion of an image(s) desired.

Regarding claim 5, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating--* an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2).

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Wordperfect fails to explicitly disclose: *converting the data representing the image into a compressed format prior to inserting the data into the document*. However, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches above the benefit of reduction of memory and processing time required to process the image.

Regarding independent claim 18, Wordperfect teaches the acquisition, transfer, and insertion of scanned images, from an *active* TWAIN scanner, under control of a wordprocessing application, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). The scanning, and insertion of the images is made using a scheme or a number of prescribed steps.

Moreover, Wordperfect teaches the insertion of scanned images directly into a textual document without saving the images to a file prior to inserting them into the document (page 1). Wordperfect fails to explicitly teach *converting said data representing the selected image into a compressed format, and (e)*. Sobol discloses the compression of image(s), not compressed, before inserting in a document (col.4, lines 37-col.5, and line 18). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combine the teachings of Wordperfect, and Sobol, because Sobol teaches above the benefit of reducing the amount of memory and processing time require to store, and process the images.

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Regarding claim 21, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application, such as a slide presentation made up of individual slides (pages 1-2, 5).

Regarding claim 22, which depends on claim 18, Wordperfect teaches the editing, and adjusting—*enhancing*-- of scanned images, using image-editing tools incorporated within the wordprocessor (pages 3-4).

Claim 23 is directed towards a computer-readable medium for storing the steps found in claim 18, therefore is similarly rejected.

Regarding claim 32, which depends on claim 24, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *the image is acquired by scanning a graphic source that has edges of the graphic source so as to automatically crop a scanned field included within the graphic source in the image, the image being so cropped prior to the data representing the image being inserted into the document.* However, Sobol discloses the selection of a specific portion of an image prior to inserting the image into a document, detecting the edges, thereby leaving unwanted data out, and cropping them to comply with the user's selection (col.4, lines 21-67). It would have been obvious to a person of ordinary skill in the art at the time of the

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invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches above, allowing the benefit of customizing a desired image by allowing the user to crop and select desired portions of the image. Therefore, a user would be able to select only the portion of an image(s) desired by a user.

Claim 33 is directed towards a system for implementing the steps found in claim 5, and therefore is similarly rejected.

17. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Photoimpact, and further in view of Mastering Photoshop 5 for the Web, hereinafter Photoshop (1998, pp.1-10).

Regarding claim 7, which depends on claim 6, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancement criterion is a contrast level of the image that is adjusted to enhance brightness*. However, Photoshop teaches the altering of an image contrast/brightness (p.8,L.1-28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the benefit of increasing the legibility of a textual document. This would increase the legibility of the image obtained by the scanner, or device.

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Regarding claim 8, which depends on claim 6, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancement criterion is a color level of the image...based on a gamma correction algorithm*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the benefit of customizing of an image to be compatible with the colors of a specific computer platform. This would increase the legibility of the image obtained by the scanner, or device.

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Photoimpact, and further in view of "Troubleshooting and configuring the Windows NT/95 Registry", Clayton Johnson, hereinafter Johnson (1997, pp.1-2).

Regarding claim 11, which depends on claim 10, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *a set of capabilities are associated with the image source devices...and are stored in an operating system registry*. However, Johnson teaches the settings and capabilities of hardware being stored in a computer's Windows registry (p.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of

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Wordperfect, and Johnson, because Johnson teaches about storing hardware information in a registry to enable an operating system to control and run those devices.

19. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Photoimpact, and further in view of TWAIN specification version 1.8, 110/22/98, hereinafter Twain (IDS filed on 8/23/99).

Regarding claim 13, which depends on claim 12, Wordperfect teaches the scanning of an image into a document by simply choosing an "Acquire Image" menu option (page 1).

Wordperfect fails to explicitly disclose: *the device that is active has an X, and a Y resolution, and includes a driver that provides a user interface for selecting image capture parameters, (a) confirming that said image source device can control its X resolution; (b) confirming that said image source device can control its Y resolution; (c) confirming that the user interface can be bypassed, wherein an affirmative answer to all of the steps of confirming indicates that said image source device can perform the automatic image scan.* However, Twain teaches negotiating capabilities, such as X, Y resolution supported by a device (page 69, page 71, 14-31). Twain also teaches negotiating capabilities, such as the setting of certain x/y resolution, between a source device, and an application leads to a modification of a dialog, such as the graying out or *bypassing* of the dialog (page 116, lines 7-34, page 70, part 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Photoimpact and Twain, because Twain teaches the benefit of giving control to TWAIN applications (page 65, lines 16-20).

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20. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, and in view of Twain, further in view of Photoimpact, and further in view of Arakawa (Pat. #5,845,076, 12/1/98).

Regarding claim 14, which depends on claim 12, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *setting an error flag*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Arakawa, because Arakawa teaches above a scheme to discover the scanning status.

Furthermore, Wordperfect fails to explicitly disclose: *clearing the error flag if the automatic scan is successful, and evaluating the error flag..if the error flag has not been cleared*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process, and therefore the scanning cannot be completed (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Arakawa, because Arakawa teaches above a scheme to discover the scanning status of a scanner, so that a user would be informed as to the status of the scanning job.

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21. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Sobol, and further in view of Photoshop (1998, pp.1-10).

Regarding claim 19, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *the application program is a word processing application, and the plurality of images are inserted into the document as a plurality of tiled images*. However, Photoshop teaches the creation of graphics using a tiling technique (p.4,L.14-p.5). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop because Photoshop teaches above the benefit of the use of tiled images as a web page background, thereby enhancing a web page created with the wordprocessor.

22. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Sobol, and further in view of Hearn et al, hereinafter Hearn (Pat. # 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 20, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *the plurality of inserted images are inserted into the spreadsheet document as a plurality of cascaded images*.

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However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines 1-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Sobol, and Hearn, because Hearn teaches above an improvement in the way to combine different data into a single document.

23. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 26, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images into a textual document(s) located in the Wordprocessing application (pages 1-2, 6-7). Wordperfect fails to explicitly disclose: *the application program is a spreadsheet application*. However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines 1-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Sobol, and Hearn, because Hearn teaches above an improvement in the way to combine different data into a single document.

24. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, and further in view of Photoshop.

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Regarding claim 31, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancing the quality of the captured image from within the application, the captured image quality being enhanced prior to inserting the data representing the image into the application program document*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the customization of an image to be compatible with the colors of a specific computer platform.

Response to Arguments

25. Applicant's arguments filed on 6/28/04 have been fully considered but they are not persuasive. Regarding claim 1, Applicants indicate that Wordperfect does not anticipate the communicating of the acquired image into memory without saving it into a file, because it is not clear that the image is not first converted into a file and then imported directly into the Wordperfect document (page 9, lines 10-15, and 22-26). The Examiner disagrees, because Wordperfect teaches the scanning of the image from the scanner directly into the Wordperfect document. It is clear that the scanned image goes directly from the scanning source into the document without going through an intermediate file, since the image is going **directly** into the document. It seems that Applicants are reading into the Wordperfect reference, aspects not found

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in it, such as the possibility of intermediate steps. This is a mere conjecture, that reads various theoretical scenarios into the reference. The reference says that the images are directly input into the document, which means there is no intermediate saving of the images anywhere other than the document.

Regarding claim 18, Applicants submit that there is no selection scheme for selecting images for insertion into the image (page 12, lines 19-23). The Examiner disagrees, because Wordperfect teaches the use of a selection scheme based upon the guidelines of the scanner's manufacturer (pages 1-2). In other words, the scheme, or predetermined steps, to be followed in selecting the image, is circumscribed by the manufacturer of the scanning device. As established above concerning claim 1, Wordperfect teaches the direct saving of the scanned image—without saving the image anywhere else.

26. Applicant's arguments with respect to claims 1-8, and 10-33 have been considered but are moot in view of the new ground(s) of rejection. Regarding claims 1, and 24, Applicants submit that Photoimpact fails to teach the causing of the application program to negotiate with the active source device, to determine image capture parameters (page 11, lines 19-22). The applicants are directed towards the rejections of these newly amended claims, which includes the causation of the negotiation in light of the newly applied prior art.

Claims 2, 6, 10, 12, and 17 depend from independent claim 1. Therefore are rejected at least based on the rationale of the newly applied rejection above.

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Claims 4-5, 18, 21-23, and 32-33 depend from independent claims 1, and 24. Therefore are rejected at least based on the rationale of the newly applied rejection above.

Claims 7-8, 19, and 31 depend from independent claim 1. Therefore are rejected at least based on the rationale of the newly applied rejection above.

Please note that some of the claims have been rearranged to reflect the proper rejection dependency in the rejection heading. However, the respective rejections have not changed.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-2148. The examiner can normally be reached on Monday through Friday (every other Friday off) from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Any response to this Action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)



CESAR B PAULA
Primary Examiner
Art Unit 2178

1/4/05